

REMARKS

Reconsideration of this application as amended is requested.

In a telephone conversation with the Examiner, in response to a requirement by the Examiner for an election of species, the undersigned attorney made a provisional election without traverse to withdraw claims 1-5 and 7 from prosecution, and the election was made without traverse to prosecute claim 6. On behalf of the Assignee, the undersigned attorney hereby affirms that provisional election without traverse.

Claim 6 has been amended and claim 8 has been added by this amendment, and claims 6 and 8 are thus the only two claims that remain under prosecution.

In view of the Examiner's earlier restriction requirement, the Assignee reserves and retains the right to present claims 1-5 and 7 in a subsequent divisional application.

The Examiner rejected claim 6 under 35 U.S.C. § 102(b) as being clearly anticipated by O'Meara, U.S. Patent 239,111. The Examiner further and alternatively rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Beach, U.S. Patent 4,890,968, in view of Barnes, U.S. Patent 3,339,720.

Assignee respectfully traverses the Examiner's characterization of the O'Meara reference. The Examiner asserts that the O'Meara reference "discloses a stacked assembly (a) of "roofing caps" comprising a plurality of coaxially stacked roofing caps (b) wherein adjacent caps are joined together at a melted portion (c)" and further asserts that "[t]he combination with the feeding device, fastener, roof member and roof deck are an intended use of which O'Meara would be capable."

Assignee respectfully points out that O'Meara discloses not roofing caps but instead rubber washers used by plumbers for use "in packing piston-rods, pumps, valve-stems, unions, hot and cold water cocks, faucets, glass gages, couplings," and "as plumbers' washers or valve-disks, valve-stem packing, and basin cock-seats." See O'Meara, page 1, lines 7-8; O'Meara, page 1, lines 89-92; O'Meara, page 2, lines 1-5. Furthermore, the rubber

1 washers of O'Meara are not joined together at a melted portion as asserted by the Examiner,
2 but instead are formed from a tube of vulcanized rubber that has been partially cut
3 transversely through, such that the partially-severed rubber tube remains joined at uncut
4 portions. O'Meara, page 1, lines 29-33 and 45-87.

5 Not only is there no teaching or suggestion to use the non-analogous art of rubber
6 plumbers' washers for roofing caps, and not only are the rubber plumbers' washers disclosed
7 by O'Meara not joined together at a melted portion as required by claim 6, the rubber
8 plumbers' washers disclosed by O'Meara would not be suitable for feeding in the cap feeder
9 for which the roofing caps are adapted as claimed in claim 6. In order for a roofing cap to be
10 fed transversely from the stack, the roofing cap must be rigid so that it can be slid off of the
11 stack by the cap feeder's shuttle. O'Meara's plumbers' washers are not only unsuited for use
12 as roofing caps, but also O'Meara teaches that the user must take an ordinary knife to
13 separate his plumbers' washers from each other (O'Meara at page 1, lines 35-44, and page 2,
14 line 17-21) and does not teach or suggest how to modify his plumbers' washers for use as
15 roofing caps melted together or adapted for use in a roofing cap feeder as claimed in claim 6.

16 Claim 6 has been amended to further distinguish from O'Meara by reciting that the
17 caps are made of plastic. Support for this amendment may be found, for example, in
18 paragraph 5800 of the application as filed. As discussed above, the rubber plumbers'
19 washers disclosed by O'Meara cannot be fed from a stack by a cap feeder's shuttle.

20 Beach discloses stackable steel roofing washers made from a steel blank (Beach,
21 column 4, lines 49-50) that are stacked and fed into a tubular chute, but does not disclose
22 adjacent steel roofing washers being joined together at a melted portion. Barnes discloses
23 metal staples that are adhered to each other solely by autogenous welds along the entire
24 adjoining surface between adjacent staples.

25 First, there is no teaching or suggestion to somehow combine Beach and Barnes, and,
26 as discussed further hereinbelow, Assignee respectfully traverses the Examiner's assertion

1 that such a combination would be obvious to one skilled in the art at the time the present
2 invention was made. Furthermore, even if such a combination were to be made, the resulting
3 combination would have Beach's stacked steel roofing washers welded together by
4 autogenous welds along the entire adjoining surface between adjacent steel roofing washers,
5 *i.e.*, with the entire top surface of one steel roofing washer being welded to the entire bottom
6 surface of another steel roofing washer thereabove, etc. The sheering force required to
7 separate such welding of the entire top of one steel roofing washer to the entire bottom of the
8 adjacent roofing washer would be enormous, and would make construction of a shuttle-
9 operated cap feeder near to impossible and highly impractical.

10 In contrast, claim 6 has been amended to claim that the caps are plastic and are joined
11 together at a melted circumferential portion of the caps. Support for this amendment may be
12 found in paragraphs 5800 and 6650 of the application as filed.

13 The melting together of a circumferential portion of adjacent caps is not shown or
14 disclosed in the prior art, and, in fact, Beach, in a later patent in which he was named as an
15 inventor (Beach *et al.*, U.S. Patent 5,163,580, previously disclosed to the Examiner pursuant
16 to the Duty of Disclosure), instead taught to use a flexible polymeric strap through a stack of
17 roofing washers to hold the stack together. Such a strap or cord is less desirable than the
18 stack of roofing caps whereby adjacent caps are joined by melted portions on their
19 circumference because the present invention, as claimed in claim 6, can be inserted into a cap
20 feeder without having to separate a cord from the stack of washers, and permits the stack of
21 caps to be easily removed from the cap feeder and still remain together, as might be required
22 when cleaning a jammed cap feeder. In contrast, when a strap or cord is used to hold a stack
23 of caps together prior to insertion in a cap feeder and then is removed during insertion, the
24 stack of caps becomes unstacked and disorganized when removed from the cap feeder.
25 There is simply no teaching or suggestion in the prior art that recognizes the present
26 invention as claimed in claim 6.

Additionally, dependent claim 8 has been added to specifically claim a method of making the caps of claim 6. Support for added claim 8 may be found in paragraph 6650 of the application as filed. None of the references of record disclose or suggest the limitations added to claim 6 by claim 8.

In conclusion, it is respectfully submitted that the present application and all of its claims are now in condition for allowance for the reasons previously discussed. All the references cited by the Examiner have been reviewed and considered but are not felt to come within the coverage of the claims now in this case, nor are they felt to disclose or suggest the present invention as specifically defined by the claims now of record. If the Examiner is of the opinion that a telephone conference relative to this case would advance the prosecution, the Examiner is respectfully requested to call the undersigned at the indicated phone number.

A check is enclosed herewith for the fee for the concurrently-filed one month extension of time. If any further fees are required for the filing of this amendment or the papers filed concurrently herewith, please charge such additional fees or credit any overpayment to Deposit Account 23-0125.

Formal favorable action and issuance of a timely Notice of Allowance is respectfully requested.

Respectfully submitted,

PneuTools, Incorporated, Assignee

Date: 11/28/2005

By: Russell H. Wile

Russell H. Walker
U.S.P.T.O. Registration No. 35,401
Attorney for Assignee

Walker, McKenzie & Walker, P.C.
6363 Poplar Ave., Suite 434
Memphis, Tennessee 38119-4896
Tel. No. (901) 685-7428
Fax No. (901) 682-6488